

## **REMARKS**

Claims 1-14 and 16-40 are currently pending. On October 24, 2005, the Examiner rejected claims 6, 7, 23-25, 36, 37, 39, and 40, and allowed claims 1-5, 8-14, 16-22, 26-35, and 38. In response, Applicant amends claims 6, 7, 36, 37, 39, and 40. Applicant respectfully traverses the rejection and requests reconsideration based on the following remarks.

### **Claim Rejections under 35 U.S.C. § 112, First Paragraph**

The Examiner rejected claims 36, 37, and 40 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Regarding claims 36, 37, and 40, the Examiner indicated that “small diameter end substantially sealing against inside wall of pipe” is not consistent with the originally filed disclosure. In response, Applicant amends claims 36, 37, and 40 to comply with the written description requirement and thereby, overcomes the § 112, first paragraph rejection. More specifically, Applicant amends claims 36, 37, and 40 to include that the large diameter end, and not the small diameter end, seals against the inside wall of the pipe. For example, as shown in FIG. 6, large diameter end seals against the inside wall of pipe 308. Therefore, Applicant respectfully requests the Examiner to withdraw the § 112, first paragraph rejection.

### **Claim Rejections under 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected claims 6, 7, 23-25, 36, 37, and 40 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

### Claims 6-7

The Examiner has indicated that the Office Action dated October 24, 2005 is a Final Office Action. However, the rejection of claims 6-7 is a new grounds of rejection because the rejection was neither necessitated by any of Applicant's previous amendments of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.17(c) with the fee set forth in 37 CFR 1.17(p). MPEP 706.07(a). While claims 6 and 7 were previously rejected as being indefinite, they were not rejected on these new grounds as being indefinite based on whether the tow line is "connected to the remaining structural limitations...[or] directed to an aggregation of parts." Office Action, page 2, dated October 24, 2005. Therefore, based on this new grounds of rejection for claims 6 and 7, Applicant believes that the Final Rejection is premature and respectfully requests the Examiner to withdraw the Final Rejection.

The Examiner rejected claims 6 and 7 because the Examiner could not determine whether the "tow line" is connected to the structural limitation or is directed to an aggregation of parts. In response, Applicant amends these claims to more particularly point out and distinctly claim the subject matter which Applicant regards as his invention. More specifically, Applicant includes that tow line is coupled to the central portion of the apparatus and is thus a structural limitation. Therefore, Applicant respectfully requests the Examiner to withdraw the § 112, second paragraph rejection.

### Claims 23-25

The Examiner rejected claim 23 questioning whether the subject matter “passing the sonde...around the sonde cable” is in the written description. In response, Applicant asserts that phrase “passing the sonde...around the sonde cable” is supported at least by FIGS. 2A, 3 and 4 and page 12, paragraphs 49-51. Claim 23 is fully supported in paragraphs 49-51. For example, the specification states:

FIGS. 3 and 4 illustrate an embodiment of a sliding pipe plug 201 according to the present invention. As shown in FIGS. 2A and 2B, embodiments of sliding pipe plug 201 travel through pipe section 205 when pulled along by cable 202. Cable 202 may house electrical signal lines from sonde 203 (FIG. 2A), as well as provide the mechanical strength to slide apparatus 201 and sonde 203 through section 205.

Sliding pipe plug 201 includes a central portion 208 which is attached to cable 202. Gasket 209 is attached to central portion 208 and forms a seal with the inner wall of pipe 205 as sliding pipe plug 201 is towed through pipe section 205. Central portion 208 can include section 302 and end-caps 305. Section 302 may be, for example, a section of pipe smaller in diameter than pipe section 205. In some embodiments, section 302 has a diameter large enough to allow sonde 203 to pass through section 302.

Page 12, paragraphs 49-50.

In other words, the specification states that the sonde can pass through the center section of the sliding pipe plug (e.g. section 302) until the center section is around the sonde cable (e.g. as shown in FIG. 3). Therefore, Applicant respectfully asserts that the limitations of claim 23 are fully supported in the specification and drawings and requests that the 112, second paragraph rejection be withdrawn.

Claims 24 and 25 are dependent upon claim 23 and appear to be rejected based on their dependency upon claim 23. Consequently, since Applicant believes that the 112 rejection should be withdrawn against claim 23 because the claim 23 is fully supported, Applicant also believes that the 112 rejection should be withdrawn against claims 24 and 25.

#### Claims 36, 37, and 40

Examiner rejected claims 36, 37, and 40 stating that the claim language pertaining to a small diameter end sealing against the inside wall of the pipe is inconsistent with the disclosure. The Examiner stated that the disclosure seems to suggest that it is the large diameter end that seals against the inside wall. The Examiner further questions whether the Applicant is trying to inject new matter or if the claims were simply missing one or more commas. In response, Applicant amends claims 36, 37, and 40 to include that the large diameter end, not the small diameter end, seals against the inside wall of the pipe. Applicant asserts that the claims were missing well-placed commas. After further reviewing the claims, Applicant decided to amend the claim to better define the invention instead of incorporating the commas into claims 36, 37, and 40. Applicant believes that claims 36, 37, and 40 are now more distinctly claimed. Therefore, Applicant respectfully requests the Examiner to withdraw the 35 U.S.C. § 112, second paragraph rejection.

#### **Claim Rejections under 35 U.S.C. § 102(b)**

To establish a proper 102 rejection, each element of the claim must be disclosed expressly or inherently within the prior art. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Jenkins et al.

Applicant respectfully traverses the rejection of claims 37 and 40 under 35 U.S.C. 102(b) as being anticipated by Jenkins et al. (U.S. Patent No. 5,770,800; hereafter “Jenkins”). Applicant respectfully disagrees with the Office Action that Jenkins discloses a conical section. However, to expedite prosecution, the Applicant amends the claims.

With respect to claim 37, Jenkins fails to teach “means for supporting the large diameter end, wherein the supporting means is coupled to the inside portion of the large diameter end of the conical section so that the large diameter end substantially seals against the inside wall of the pipe” (emphasis added). Jenkins discloses having a seal, wherein the seal appears to be a circular shape. However, Jenkins fails to disclose having a supporting means that are coupled to a large diameter end so that the large diameter end substantially seals against the inside wall of the pipe. Jenkins discloses portions 156/166 that pull away from the seal as the joint flexes so portions 156/166 do not provide the support that is required in claim 37. Jenkins at 6:22-36. Thus, Jenkins fails to expressly or inherently disclose “means for supporting the large diameter end, wherein the supporting means is coupled to the inside portion of the large diameter end of the conical section so that the large diameter end substantially seals against the inside wall of the pipe” (emphasis added). Therefore, claim 37 is allowable over Jenkins.

Claim 40 is similar in scope to claim 37 and is allowable for the same reasons as claims 37.

Therefore, the rejection of claims 37 and 40 under § 102(b), as anticipated by Jenkins, is improper and should be withdrawn.

Huber

Applicant respectfully traverses the rejection of claims 36, 39, and 40 under 35 U.S.C. 102(b) as being anticipated by Huber (U.S. Patent No. 6,082,183).

Regarding claim 36, Huber fails to teach a “means for supporting the large diameter end; and means for breaking the seal when pulling opposite the tow line, wherein the breaking means release the pressure applied by the supporting means on the large diameter end of the conical section so the large diameter end does not substantially seal against the inside wall of the pipe” (emphasis added). Huber discloses a removable test baffle that seals a pipe in order to test whether the pipe leaks or not. Huber also discloses a lug having an eye that allows a line to pull the baffle. However, Huber fails to teach means for supporting the large diameter end wherein the breaking means release the pressure applied to the supporting means so that that the large diameter end does not substantially seal against the inside wall of the pipe. As shown in FIGS 3, 4A-C, and 6, Huber’s seal is shaped to engage the inside portion of the pipe, but Huber’s baffle does not include a support coupled to the large diameter end so the large diameter end substantially seals against the pipe. Consequently, Huber could not release the pressure applied by the supporting means to the large diameter end. Thus, Huber fails to expressly or inherently disclose “means for supporting the large diameter end; and means for breaking the seal when pulling opposite the tow line, wherein the breaking means release the pressure applied by the supporting means on the large diameter end of the conical section so the large diameter end does not substantially seal against the inside wall of the pipe” (emphasis added). Therefore, Applicant’s claim 36 is patentable over Huber.

Claim 39 is similar in scope to claim 36 and is patentable for the same reasons as claim 36.

Regarding claim 40, Huber fails to teach a “a support coupled to the inside portion of the large diameter end of the conical section so that the large diameter end substantially seals against the inside wall of the pipe” (emphasis added). Huber discloses a removable test baffle that seals a pipe in order to test whether the pipe leaks. As shown in FIGS 3, 4A-C, and 6, Huber’s seal is shaped to engage the inside portion of the pipe, but Huber’s baffle does not include a support coupled to the large diameter end so the large diameter end substantially seals against the pipe. Thus, Huber fails to expressly or inherently disclose “a support coupled to the inside portion of the large diameter end of the conical section so that the large diameter end substantially seals against the inside wall of the pipe” (emphasis added). Therefore, Applicant’s claim 40 is patentable over Huber.

Therefore, the rejection of claims 36, 39, and 40 under § 102(b), as anticipated by Huber, is improper and should be withdrawn.

#### Biggerstaff

Applicant respectfully traverses the rejection of claim 37 under 35 U.S.C. 102(b) as being anticipated by Biggerstaff (U.S. Patent No. 4,866,978). Applicant respectfully disagrees with the Office Action that Biggerstaff discloses a conical section. However, to expedite prosecution, the Applicant amends the claims.

With respect to claim 37, Biggerstaff fails to teach “means for supporting the large diameter end, wherein the supporting means is coupled to the inside portion of the large diameter end of the conical section so that the large diameter end substantially seals against the inside wall of the pipe” (emphasis added). Biggerstaff discloses having a diaphragm, wherein the diaphragm appears to be a circular disc shape. As shown in FIG. 2, Biggerstaff discloses a

diaphragm that has “elastomeric” material that has sufficient strength so that it may seal against the inside wall. Biggerstaff also discloses a backplate 36 that holds the diaphragm in place.

However, Biggerstaff fails to disclose having supporting means so that the large diameter end of the conical section substantially seals against the inside of wall of the pipe. As stated above, the backplate 36 only holds the diaphragm in place and is not coupled to the inside portion of the outer end of the diaphragm so as to support the outer end to substantially seal against the inside wall of the pipe. Thus, Biggerstaff fails to expressly or inherently disclose “means for supporting the large diameter end, wherein the supporting means is coupled to the inside portion of the large diameter end of the conical section so that the large diameter end substantially seals against the inside wall of the pipe” (emphasis added).

Therefore, the rejection of claim 37 under § 102(b), as anticipated by Biggerstaff, is improper and should be withdrawn.

### **Double Patenting Rejections**

The Examiner has provisionally rejected claim 37 under the judicially created doctrine of double patenting over claim 35 of co-pending Application No. 10/306,403.

Based on the amended claims, Applicant believes that all other rejections should be withdrawn. MPEP 804 states

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.



Therefore, the provisional double patenting rejection should be withdrawn.

**Allowable Subject Matter**

Applicant thanks the Examiner for indicating that claims 1-5, 8-14, 16-22, 26-35, and 38 stand allowed.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: \_\_\_\_\_

  
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